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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,258	05/01/2001	Kazuhiro Ogura	016907/1228	2847

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EXAMINER

BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,258

Applicant(s)

OGURA ET AL.

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-15 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/01/01 and 08/24/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 08/09/2006.

2. Claims 1-9, 16-25, and 27-28 have been cancelled by the Applicant.

Claims 10-15 and 26 are presented for examination.

3. Amendments to claims 10-15, 26, and the specification have been considered.

Claim Rejections - 35 USC § 112

4. The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claim recites, "a registration processing portion which, when **a specific user is designated in a state** where the selection window is displayed." The scope of this statement is unclear, since it is unclear what is meant by "**a specific user is designated in a state**". Specifically, it is not clear what state this is referring to. It is interpreted to mean that there is a registration processing portion that is displayed in a second display portion.

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. Specifically, the claim recites, "said first display portion, said registration button, said second display portion and said registration processing portion are provided in **a shared advertisement apparatus**." The scope of this statement is unclear, since it is unclear what is meant by "**a shared advertisement apparatus**". Specifically, it is not clear what state this is referring to. It is interpreted to mean that there the first and second display portions are displayed on one computer screen simultaneously.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the claim introduces the limitation "a second display portion which displays a selection window for designating a user, when the registration button is pressed; a registration processing portion which, when a specific user is designated in a state where the selection window is displayed in said second display portion, causes said memory to store bookmark information associating information indicative of the designated user with information related to the piece of merchandise displayed by said first display portion when said registration

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button is pressed,” and this constitutes new matter, as this claim limitation is not supported by the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10-15 and 26, are rejected under 103 (a) as being anticipated by the America Online Tour Guide Version 3 published in 1996 (hereinafter AOL guide) in view of Desktop.com homepage from Internet Archives published on 12/06/2000 (hereinafter Desktop.com-1), further in view of the article titled “Desktop.com Unveils the First Free Internet Desktop and Application Platform for the Internet” by Business Editors and High Tech Writers, published in Business Wire on September 20, 1999 on page 1 (hereinafter Desktop.com-2), and further in view of DzSoft Favorites Search from Internet Archives published on 11/09/2000 (hereinafter DzSoft).

Disclaimer: Claim 10 was found to be deficient under U.S.C. 112 first and second paragraphs. To the extent the claimed invention was understood, the following art was applied.

In reference to claim 10, the AOL guide teaches *an advertisement system, which provides an advertisement of merchandise to a number of users, comprising: a first display portion that displays the advertisement of merchandise*

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(page 79 Figure 3-11) (i.e. e-mail viewable on a monitor); a memory that stores, as a bookmark, *information associating information (i.e. this is interpreted to mean information)* related to the piece of merchandise displayed by said *first display portion with information indicative of a user (i.e. a user adds favorites to his personal list)* (page 78 lines 8-14, page 127 lines 23 to page 129 lines 3, and Figure 4-7) (i.e. the heart icon bookmarks a favorite page and stores it in a browser); a registration button (i.e. the heart icon) that instructs the digital copying machine to register the information related to the piece of merchandise as the bookmark in said memory when the advertisement of the piece of merchandise is being displayed on said display device (page 78 lines 8-14, page 127 lines 23 to page 129 lines 3, and Figure 4-7) (i.e. the AOL guide is generic regarding the content of the websites that are bookmarked and includes websites that can have advertisements on them as well); and a transmitter (i.e. a server that transmits information) that transmits the information related to the piece of merchandise to the external device as data displayable on the external device, the data displayable on the external device containing link information linked with a site on the Internet where the piece of merchandise is on sale (i.e. add the heart icon for a favorite site link to an e-mail message) (page 78 lines 1-17).

The AOL guide is silent about a second display portion, which displays a selection window for designating a user, when the registration (i.e. login or new registration) button is pressed. Desktop.com-1 teaches a second display portion, which displays a selection window for designating a user, when the registration (i.e. login or new registration) button is pressed (see the right frame that asks for

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a username and password to login or where the user can click on new account to register for a new account). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the AOL guide to include providing a second display portion, which displays a selection window for designating a user, when the registration button is pressed to enable the user to login to his account and to view the user's favorites that he had previously saved under his login identification.

The AOL guide is silent about a registration processing portion which causes said memory to store bookmark information displayed by said first display portion when said registration button is pressed in a selection window.

Desktop.com-2 teaches a registration processing portion which causes said memory to store bookmark information displayed by said first display portion when said registration (i.e. login) button is pressed in a selection window (page 1 lines 1-9). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the AOL guide to include providing a registration processing portion which causes said memory to store bookmark information displayed by said first display portion when said registration button is pressed in a selection window, to enable the user to add favorites to his login identification and to have the bookmarks available from any other computer as well.

The AOL guide is silent about a search portion, which searches all bookmark information corresponding to the information indicative of the designated user, when the information indicative of the user is received from an

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external device; and where the transmitted information is based on the bookmark information searched by said search portion. DzSoft teaches a search portion which searches all bookmark information corresponding to the information indicative of the designated user, when the information indicative of the user is received from an external device (See the screenshot of DzSoft Favorites Search where there is a search for bar where a user can type in a search to search his favorites). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the AOL guide to include providing search portion, which searches all bookmark information corresponding to the information indicative of the designated user, when the information indicative of the user is received from an external device in order to enable users to quickly find a particular link from their favorites list. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the AOL guide to transmit searched bookmarks to again save the user the time from having to go down the list of favorites to find a link rather than quickly searching for the needed link and attaching it to a message.

8. In reference to claim 11, the AOL guide teaches *an advertising system* wherein the link information contains information representing a presenter of the piece of merchandise (i.e. the advertiser) (page 78 lines 1-17).

9. **Disclaimer:** Claim 12 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

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In reference to claim 12, The AOL guide teaches a memory and a transmitter in a server apparatus having a communication portion, which accesses the external device through a network (i.e. the favorites are stored in memory and can be accessed when the user logs on to his AOL account over a network from a computer) (page 128 and Figure 4-7).

The AOL guide does not teach an advertising system, wherein said first display portion, said registration button, said second display portion and said registration processing portion are provided in a shared advertisement apparatus and said memory. Desktop.com-1 teaches an advertising system, wherein said first display portion, said registration button (i.e. login or register button), said second display portion (i.e. the main frame) and said registration processing portion (i.e. the right frame) are provided in a shared advertisement apparatus (i.e. on the same computer screen where the right frame that asks for a username and password to login or where the user can click on new account to register for a new account). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the AOL guide to include a first display portion, said registration button, said second display portion and said registration processing portion in a shared advertisement apparatus to enable the user to login to his account and to view additional information being presented in the main frame simultaneously.

The AOL guide is silent about a search portion. DzSoft teaches a search portion which searches all bookmark information (See the screenshot of DzSoft Favorites Search where there is a search for bar where a user can type in a

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search to search his favorites). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the AOL guide to include providing search portion, which searches all bookmark information in order to enable users to quickly find a particular link from their favorites list.

10. In reference to claim 15, the AOL guide teaches an advertisement system, wherein said memory stores the information related to the piece of merchandise as the bookmark in units of the *advertisement system* capable of displaying advertisements of merchandise, (i.e. bookmarks associated with a computer which can also be associated with a user) and units of users (i.e. bookmarks associated with a particular user), and for a user who has accessed said *advertisement system* by the external device (i.e. the user logs in and can view his bookmarks and can send these bookmarks to others) (page 78 lines 8-14), said transmitter (i.e. a server that transmits information) transmits the information related to the piece of merchandise registered as the bookmark corresponding to said digital copying machine to the external device as the data displayable on the external device (i.e. an e-mail with a hyperlink) (page 78 lines 8-14 and Figure 4-7).

11. In reference to claim 26, the AOL guide teaches an advertisement method of providing an advertisement of merchandise operable on *an advertising system* that provides an advertisement of merchandise to be sold on the Internet, comprising: displaying the advertisement of merchandise on a *first display portion* of the *advertisement system* (page 79 Figure 3-11) (i.e. e-mail viewable

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on a monitor), storing, as a bookmark, *information associating* information related to the piece of merchandise displayed on the *first display portion with information indicative of a user* (page 128 see Figure 4-7 that indicates when you add a favorite it shows up in a display portion of your favorite places) in a memory of the *advertisement system*; and (page 78 lines 8-14, page 127 lines 23 to page 129 lines 3, and Figure 4-7) (i.e. the heart icon bookmarks a favorite page and stores it in a browser); in accordance with an access from an external device, transmitting the information related to the piece of merchandise as the bookmark from the *advertising system* to the external device as data displayable on the external device (i.e. add the heart icon for a favorite site link to an e-mail message) (page 78 lines 1-17), the data displayable on the external device containing link information linked with a site on the Internet where the piece of merchandise is on sale, and the link information containing information representing a presenter of the piece of merchandise (i.e. the AOL guide is generic regarding the content of the websites that are bookmarked and includes websites that can have advertisements on them as well) (page 78 lines 1-17).

12. Claims 13 and 14 are rejected under U.S.C. 103(a) as being unpatentable over the AOL guide in view of in view of Desktop.com-1, further in view of the Desktop.com-2, further in view of DzSoft, and further in view of Official Notice.

In reference to claims 13 and 14, the AOL guide teaches a digital copying machine, (i.e. an advertisement system), that transmits the e-mail message *data* having the information of the piece of merchandise, including the link information linked with the site on the Internet where the piece of merchandise is on sale

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(page 78 lines 8-14 and Figure 4-7). The AOL Guide does not teach the system wherein said mail transmission device is a radio communication module for performing *in the server apparatus* short-distance radio communication and connects to a portable terminal designated by said input device and connectable by short-distance radio communication to and where the link information is sent to the portable terminal.

Official Notice is taken that it is old and well known for a system to include a radio communication module *for performing in the server apparatus short-distance radio communication*, since this enables users to communicate wirelessly via a cell phone for example. Official Notice is also taken that is old and well known for a system to include sending link information to a portable terminal when the user is using a hand-held device such as a PDA to access information provided online by the WWW server. Furthermore, some type of an Internet connection and a device is required to carry out the AOL e-mail and bookmark service online. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include a radio communication device such as a cell phone connected to a network such as the Internet and the WWW server to enable users to utilize the service of recommending websites as provided by companies such as AOL wirelessly.

Response to Arguments

13. After careful review of Applicant's remarks/arguments filed on 08/09/2006, the Applicant's arguments with respect to claims 10-15 and 26 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments

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to the specification and to the claims have been entered and considered.

14. The previously made rejections under 35 USC § 112 have been removed in view of the amendments. However, the amendments lead to the introduction of new 35 USC § 112 rejections.

15. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

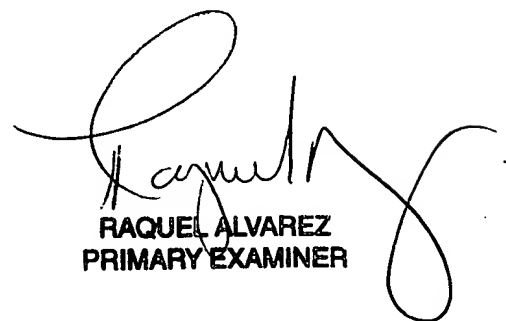
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



N.B.

October 29th, 2006


RAQUEL ALVAREZ
PRIMARY EXAMINER